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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Isaac Cohen

Group Art Unit: 2838

Application No. : 09/684,850

Examiner: BERHANE, Adolf D.

Filed : October 6, 2000

For : *DRIVE CIRCUIT FOR SYNCHRONOUS RECTIFIERS*

RESPONSE TO REQUIREMENT FOR RESTRICTION
UNDER 35 U.S.C. §121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant presents the following remarks in response to the Official Action dated February 12, 2004.

In the Office Action, restriction in this case under 35 U.S.C., §121, is required to one of the following inventions:

- I. Claims 1-42, drawn to a Power converter with conduction of rectifier device, classified in class 363, subclass 84;
- II. Claims 45-79, drawn to a Power converter or method for driving a synchronous rectifier, classified in class 363, subclass 21.06;
- III. Claim 80, drawn to a converter that provides a bias power supply, classified in class 363, subclass 21.01; and
- IV. Claims 81-82, drawn to a maximum duty cycle for a pulse width modulator, classified in class 363, subclass 21.01.

As an initial matter, Applicant respectfully notes that the above claim groupings of Inventions I-IV do not include claims 43 and 44, which depend on claim 42. In view of such claim dependency and the asserted restriction of the claims into Inventions I-IV, Applicant respectfully submits that Invention I should also include claims 43 and 44.

In response to the Requirement for Restriction, Applicant provisionally elects, with traverse, to prosecute the claims that correspond to Invention I from among Inventions I-IV into which the Office Action has classified the pending claims. As explained above, Applicant respectfully submits that Invention I should include claims 43 and 44 in addition to the claims identified in the Office Action, namely, claims 1-42.

According to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be serious burden on the examiner if restriction is not required. [Emphasis added.]

The Office Action states that Inventions I-IV are distinct because they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects, and are thus unrelated (citing MPEP §§ 806.04, 808.01). The Office Action thus concludes that restriction is proper because the inventions are distinct and have acquired a separate status in the art as shown by their classification.

Applicant respectfully traverses, in part, the requirement for restriction on the grounds that searching Inventions I and II would not be unduly burdensome and,

in fact, would be necessary to ensure a complete search for a proper examination on the merits of any one of Inventions I and II. For example, claims of Inventions I and II each relate to and embrace controlling the timing of switching a rectifier in a power converter. In this regard, Applicant also respectfully draws the Examiner's attention to similarities in the recitations set forth in various claims directly or indirectly dependent upon claim 1 and claim 45, such as, by way of example only, claims 9-19 as compared with claims 46-56.

Applicant respectfully submits that such a commonality in subject matter being searched not only indicates that it would not be unduly burdensome to search Inventions I and II as grouped in the Office Action, but also that in searching either Invention I or Invention II (as grouped in the Office Action) all the classes/subclasses identified in the Office Action for Inventions I and II should be searched in order to be sure that all pertinent art is considered for a proper examination on the merits.

Accordingly, Applicants submit that it cannot be said that to examine the claims of Inventions II in addition to the claims of Invention I would place an additional "serious" burden on the Examiner, as examination of the claims of Invention II would not require undue diverse searching beyond that which would be necessary for proper examination of the claims of Invention I. Thus, with respect to Inventions I and II, it is respectfully submitted that all restricted claims are properly presented in the same application, undue diverse searching would not be required, and all such claims (as well as claims 43 and 44) should be examined together.

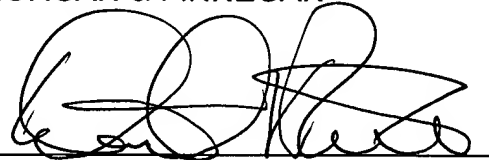
For the foregoing reasons, Applicant respectfully requests that the restriction requirement be withdrawn as to Inventions I and II, and that all claims in these

groups (i.e., claims 1-79) examined on the merits.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

MORGAN & FINNEGAN

A handwritten signature in black ink, appearing to read 'David V. Rossi', written over a horizontal line.

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Date: May 12, 2004

By:

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